REMARKS

Applicant submits the within Amendment in response to the Official Action mailed January 16, 2003. A petition to extend the term for response to said Official Action, to and including July 16, 2003, is transmitted herewith.

Applicant respectfully requests reconsideration and allowance of claims 12-17, which are the claims that remain pending in the above-identified patent application. Claims 12, 13, 15 and 16 have been amended. Claims 31-38 have been added. No new matter has been added by this Amendment.

The Examiner has rejected claims 12, 13, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Smith, III*, U.S. Patent 5,466,158 ("*Smith*"), in view of *Walter et al.*, U.S. Patent 6,313,474 ("*Walter*"). Applicant respectfully traverses this rejection.

Applicant has amended independent claim 12 to particularly point out and distinctly claim at least one important aspect of applicant's invention. With this clarification, it is clear that the claimed invention distinguishes over the cited references. In addition, applicant has added new claims 31-38 to further clarify and distinctly claim one or more important aspects of the present invention. Support for these claims may be found in the specification by way of the originally filed claims 1-11, pages 17-20, as well as in the detailed description, pages 9-15.

In particular, claim 12, as amended, requires:

A method for electronically storing text and audio content <u>of a book</u> for use in an electronic book reader system, <u>said electronic book reader system including a book holder for holding said book</u>, the method comprising the steps of:

<u>providing a book comprising a plurality of pages having text thereon, said book being adapted, arranged and structured so as to be held by said book holder of</u>

said electronic book reader system so as to be viewed by a user;

creating electronic equivalent representations of said text of said book and audio content corresponding to said text;

storing said electronic equivalent representations in a first electronic memory space; and

downloading a duplicate of said electronic equivalent representations stored in said first electronic memory space into a second electronic memory space housed within said book holder of said electronic book reader system, said downloaded duplicate of said electronic equivalent representations stored in said second electronic memory space corresponding to said pages of said book held by said book holder, whereby said electronic equivalent representations of said second electronic memory space include audio content corresponding to said pages of said book being held by said book holder and viewed by the user.

The underlined portions represent the additional language included in newly amended independent claim 12. Support for these amendments is found on page 13, lines 12-24.

As acknowledged by the Examiner, *Smith* fails to teach the downloading/storing of a duplicate of the electronic equivalent representations. The Examiner cites *Walter* in an attempt to cure the deficiencies of *Smith*. *Walter* discloses a simple and efficient technique to exchange information between an "electronic" book and an upgrade cartridge. The *Walter* specification states:

The technique facilitates the programming of the electronic book at the manufacturing phase. The technique also simplifies the upgrade of the electronic book in the field.

(*Id.* col. 5, lns. 43-48.) In short, *Walter* is directed to an "electronic" book, such as a handheld personal digital assistant, i.e., a PDA or the like, which is likely capable of

storing the contents of a conventional book having pages. That is, *Walter* describes an "electronic" book that contains the content of printed materials or books. *Walter* is not directed to an actual, physical book having pages, as "pages" is defined in the conventional sense of the word.

Applicant respectfully submits that *Walter* fails to teach or suggest at least some of the claimed features of newly amended independent claim 12, for example, having an electronic book reader system that includes "a book holder for holding the book." The book includes "a plurality of pages having text thereon" and is "adapted, arranged and structured so as to be held by said book holder of said electronic book reader system so as to be viewed by a user." Furthermore, claim 12 includes the step of "downloading a duplicate of said electronic equivalent representations." This step includes a downloaded duplicate "corresponding to said pages of said book held by said book holder, whereby said electronic equivalent representations of said second electronic memory space include audio content corresponding to said pages of said book being held by said book holder and viewed by the user." Rather, *Walter* at most only discloses transferring the entire content of the cartridge content 390 to the flash file system 342 in an "electronic" book.

Specifically, as stated by the Examiner, claim 5 of *Walter* requires, in part, "wherein transferring information transfers content of the cartridge storage to the on-board storage when the identified transfer mode is the restore mode." As explained in the *Walter* specification:

> The cartridge content 390 is a storage device that contains the content of the reading printed materials or books stored in the electronic book 220. The cartridge content 390 corresponds to the flash file system 342 in the electronic book 220. . . . If a restore operation is selected, the content of the

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cartridge content 390 is transferred to the flash file
system 342 via the data path 302.

(*Id.* col. 5, lns. 56-67.)

In addition, the *Walter* specification discloses:

If a restore operation is selected, the process
400 erases the on-board PROM and/or the on-board flash
file system (Block 460).   Then the process 400
transfers the cartridge PROM and/or the cartridge
content to the corresponding on-board PROM and/or the
on-board flash file system (Block 465).

(*Id.* col. 6, lns. 31-37.)

Thus, applicant respectfully submits that *Walter*
discloses the transferring of the entire content of the
cartridge 390 to the flash file system 342 of an electronic book
220.   Significantly, *Walter* fails to teach or suggest the
downloading of a duplicate of electronic equivalent
representations into a book holder to correspond with pages of
the book being held by the book holder and viewed by the user.

For the foregoing reasons, applicant submits that the
combination of the *Smith* and *Walter* references (to the extent
that they may properly be combined, which applicant does not
concede) fails to disclose each and every feature of the
invention as recited in independent 12.   Further, claims 13-17
and 31-38 depend from independent claim 12, either directly or
indirectly, and contain all of the limitations thereof, as well
as other limitations that are neither disclosed nor suggested by
the prior art of record.

Moreover, even if *Walter* disclosed downloading a
duplicate of electronic equivalent representations into a second
electronic memory space, where those duplicate electronic
equivalent representations correspond to pages, as recited in
the claims of the instant application (which *Walter* does not),
that teaching could not properly be combined with the *Smith*

reference because to do so would render the *Smith* system unsatisfactory for its intended purpose, and, therefore, there would be no suggestion or motivation to make such modification. M.P.E.P. § 2143.01.   That is, *Smith* contains physical pages. *Walter* teaches downloading the entire content of a book for an electronic book reader.   There would be no need to correspond the downloaded information to individual pages as required by *Smith* in order to be interactive with a user.   The *Walter* reference specifically teaches away from having electronic equivalent representations corresponding to pages of a book because, as discussed above, *Walter* is directed to an "electronic" book, one having <u>no</u> <u>physical</u> pages.   It would therefore be improper to combine the *Walter* reference with *Smith* because there would be no motivation for one skilled in the art to modify *Smith* in a way as suggested by the Examiner.

Moreover, applicant submits that the Examiner's conclusory statement that "it is understood that the information is stored according to the pages, as it is well known and understood for books" is improper, as the Examiner has not cited a reference in support of his conclusion.   Applicant respectfully requests that the Examiner provide one in this context.

Accordingly, applicant submits that independent claim 12 and dependent claims 13-17 and 31-38 are patentable. As such, applicant respectfully submits that the Examiner's § 103(a) rejection of independent claim 12 and its dependent claims, with respect to *Smith* and *Walter*, be withdrawn.

Applicant has amended claims 13, 15, 16 and 17 to correct typographical errors and make minor clarification changes.   For example, in claim 16, the word "sorting" has been changed to -- storing --, and the word "following" has been

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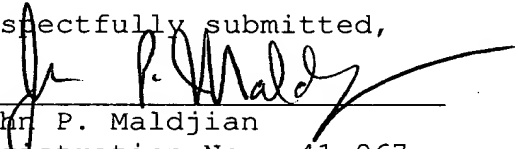changed to -- followed --.   No substantive changes have been made.

In view of the above, each of the presently pending claims in the application is believed to be in immediate condition for allowance, and favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 16, 2003

Respectfully submitted,

By _____
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